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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,325	01/03/2002	Harry W. Eberle III	(HWE-107A)	5841

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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,325

Applicant(s)

EBERLE, HARRY W. *ES*

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Fig. 7 directed to a decking system comprising an anchoring device having a substantially flat horizontal bottom element 6 having a trapezoidal shape; and,

II. No figure shown directed to a decking system comprising an anchoring device having a substantially flat horizontal bottom element 6 having a flat bottom view configuration including two parallel sides.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 3-5 and 7-10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Kenneth P. Glynn on May 12, 2003 a provisional election was made without traverse to prosecute the invention of species 7, claims 1-10. Applicant in replying to this Office action must make affirmation of this election. Claims 11-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

19. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" has been used to designate both an anchoring device with a horizontal top element 2 having parallel sides (Fig. 3) and an anchoring device with a horizontal top element having curves sides (Fig. 7).

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

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disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The disclosure is objected to because of the following informalities:

reference character 15 is referred to as a column on page 28 in line 13 and a tapered wall on page 28 in line 15 which have inconsistent names;

on page 28 in line 6, reference character 8 is referred to as a imaginary attachment line while the claim calls for an imaginary center line, the names are inconsistent; and,

on page 29 in line 11 the paragraph refers to W_{TB} as being shown in Figure 4, however, the reference character does not appear in Figure 4 but in Fig. 8. Appropriate correction is required.

Claim Objections

Claims 1 objected to because of the following informalities:

regarding claim 1, the limitation "the" in line 11 should be --an--, "its" in lines 17 and 22 should be --a--;

regarding claim 2, the limitation "its" in line 3 should be --a--;

regarding claim 5, the limitation "said" in line 10 should be deleted, "the" in line 16 should be --a--, "its" in lines 22 and 27 should be --a--;

regarding claim 8, "capable" in line 3 has an extra character; and;

regarding claim 9, --each-- should be inserted before "said board" in lines 2 and 3. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Zibell, 3,319,983 (see marked-up attachment).

Regarding claim 1, an anchoring device comprises a substantially flat horizontal top element **A1**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom element **A9**. The top element **A1** has a top view configuration including two sides **A2** and a predetermined first width **W₁** as measured side to side. The first width **W₁** is measured at a maximum width between the sides **A2**. The top element **A1** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **A1** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **W₂** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration including

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sides **A10** and a predetermined third width **W₃** as measured side to side at a maximum width. The first width **W₁** is greater than the second width **W₂** and the third width **W₃**. The third width **W₃** is greater than the second width **W₂**.

Regarding claims 2 and 6, the bottom element **A9** has a generally trapezoidal shape with a greatest width at a trapezoidal base.

Regarding claim 5, Zibell discloses in Figure 5, a decking system comprises decking boards **A** and an anchoring device **70**. Each of the decking boards **A** has a top **A21**, a bottom **A22**, two sides **A23** and two ends **A24**. At least one groove **34** is located along one of the sides **A23**. The anchoring device **70** comprises a substantially flat horizontal top element **A1**, at least one substantially vertical support member **A5**, and a substantially flat horizontal bottom element **A9**. The top element **A1** has a top view configuration including two sides **A2** and a predetermined first width **W₁** as measured side to side. The first width **W₁** is measured at a maximum width between the sides **A2**. The top element **A1** has an imaginary center line **A4**. The support member **A5** is attached to an underside **A6** of the top element **A1** along the center line **A4** and the support member **A5** extends downwardly therefrom. The support member **A5** has two sides **A7** and a predetermined second width **W₂** as measured side to side at a maximum width. The bottom element **A9** has a flat bottom view configuration including sides **A10** and a predetermined third width **W₃** as measured side to side at a maximum

width. The first width W_1 is greater than the second width W_2 and the third width W_3 .
The third width W_3 is greater than the second width W_2 .

Regarding claim 9, the groove **34** establishes an upper half of each of the decking boards **A** above the groove **34** and a lower half of each of the decking boards **A** below the groove **34**. The upper half has a greater width than the lower half.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zibell, 3,349,983.

Regarding claims 3 and 7, Zibell, as discussed above, fails to disclose the support member **A5** having recesses with support columns located therebetween. It would have been obvious matter of design choice to modify the anchoring device of Zibell by having recesses with support columns located therebetween. Since applicant has not disclosed that the recesses with the support columns solves any stated problem

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or is for any particular purpose, one of ordinary skill would remove material of the device to make the device weight less as by including recesses such as holes or slots through the support member, the top element, or the bottom element. Applicant is reminded that the support columns are inherently made as a result of the recesses being present.

Regarding claims 4 and 8, Zibell, as discussed above, fails to disclose the device made of molded plastic material. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device of plastic. *In re Leshin*, 125 USPQ 416. Furthermore, it is well known that plastic material is capable of having a metal fastener driven through.

Regarding claim 10, Zibell, as discussed above, fails to disclose the decking boards **A** made of material selected from a group consisting of synthetic polymers, at least partially foamed synthetic polymer, wood, wood composite, and combinations thereof. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the decking boards **A** out of any known material. *In re Leshin*, 125 USPQ 416.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Naccarato et al. show a similar anchoring device with recesses and columns between the recesses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600

E.G.

May 12, 2003

Attachment: one marked-up copy of Zibell, 3,319,983.

FIG. 10

